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Intellectual Property Causes
1950 Roland Clarke Place
Reston, VA 20191
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Attorney Docket No. P24684

In re application of: Makoto KAIBARA et al.

Application No. : 10/733,288

Mail Stop Amendment

Group Art Unit: 1644

Filed : December 12, 2003

Examiner: Szperka

For : BLOOD COAGULATION FACTOR-ACTICATING PROTEIN AND ANTIBODY THERETO

Mail Stop Amendment

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Transmitted herewith is an **Election with Traverse** in the above-captioned application.

_____ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

_____ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

_____ A Request for Extension of Time.

☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims:24	24	0	x 9=	\$	x 18=	\$0.00
Indep. Claims:2	3	0	x 44=	\$	x 88=	\$0.00
Multiple Dependent Claims Presented			+150=	\$	+300=	\$0.00
Extension Fees for _____ Month(s)				\$		\$0.00
Total:				\$	Total:	\$0.00

* If less than 20, write 20

** If less than 3, write 3

_____ Please charge my Deposit Account No. 19-0089 in the amount of \$_____.

N/A A check in the amount of \$_____ to cover the filing/extension fee is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).

Arnold Turk
Reg. No. 33,094

Bruce H. Bernstein
Reg. No. 29,027



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Makoto KAIBARA et al.

Group Art Unit : 1644

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THERE TO

ELECTION WITH TRAVERSE

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria VA 22314

Sir:

This is in response to the requirement for restriction under 35 U.S.C. 121 mailed from the U.S. Patent and Trademark Office on March 7, 2005, which sets a one month period for response until April 7, 2005.

Applicants note that this response is being submitted prior to the initial due date for response, whereby an extension of time and an extension of time fee are not required for maintaining the pendency of the application. However, if any government fees are required for maintaining the pendency of this application, including any extension of time fee, Applicants hereby expressly request any required extension of time and authorize that any required fee be charged to Deposit Account No. 19-0089.

Reconsideration and withdrawal of the requirement for restriction are respectfully requested in view of the remarks which follow:

RESTRICTION REQUIREMENT

The Examiner has required restriction to one of the following inventions under 35 U.S.C. 121:

I) Claims 1-7, drawn to a factor IX activating protein, classified in class 424, subclass 184.1.

II) Claims 8-14, drawn to an antibody that specifically binds a factor IX activating protein, classified in class 424, subclass 139.1

III) Claim 15, drawn to a method of detecting factor IX activating protein, classified in class 435, subclass 7.1.

IV) Claims 16, 17 and 24, drawn to a method of measuring the activity of factor IX activating protein, classified in class 435, subclass 7.2

V) Claims 18 and 19, drawn to a polypeptide of factor IX, classified in class 530, subclass 324.

VI) Claims 20-22, drawn to a method of screening for an inhibitor of factor IX activation protein, classified in class 435, subclass 7.72.

VII) Claims 23, drawn to a method using an inhibitor of factor IX activating protein, classified in class 435, subclass 7.71.

ELECTION

In order to be responsive to the requirement for restriction, Applicants elect the invention set forth in Group I, claims 1-7, with traverse.

TRAVERSE

Notwithstanding the election of the claims of Group I in order to be responsive to the Restriction Requirement, Applicants respectfully traverse the Examiner's requirement for restriction.

Initially, it is noted that the requirement for restriction omits one of the two criteria of a proper requirement as now established by U.S. Patent and Trademark Office policy, as set forth in MPEP 803, viz. that "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if a restriction were not required. Due to the aforementioned omission, it is respectfully submitted that the requirement for restriction is improper and, consequently, its withdrawal is respectfully requested.

Related to this, the requirement is traversed since there would not appear to be a serious burden to examine Applicants' application in total, and for which the appropriate claim fees have been paid. Applicants submit that it would be no serious burden on the Examiner to examine all of the pending claims, because a search for all of the claims in the above-identified application, should be made in order to do a complete and thorough search in view of the recognized relationship between the claims in Groups I to VII, as stated in the Office Action. For example, each of the inventions recited in the groups of claims includes subject matter directed to blood coagulation factor IX-activating proteins, an antibody or fragment thereof which recognizes a blood coagulation factor IX-activating protein, a method for detecting a blood coagulation factor IX-activating protein ability, a method of evaluating risk of blood coagulation in a subject with diabetes, pregnancy or aging, which includes determining the degree of activation of a blood coagulation factor IX

by the blood coagulation factor IX-activating protein, a peptide consisting of an amino acid sequence from 141th serine to 181th valine of a blood coagulation factor IX, a method of screening an inhibitor for the blood coagulation factor IX-activating protein, and a method of inhibiting the activation of a blood coagulation factor IX by the blood coagulation factor IX-activating protein.

Moreover, even if the Restriction Requirement is maintained, as noted in the Office Action, upon allowance of the claims in elected Group I, at least method claims including the subject matter of the allowed claims should be rejoined and allowed with the claims of Group I in accordance with the present rejoinder practice of the Patent and Trademark Office.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.

CONCLUSION

For the reasons discussed above, it is respectfully submitted that the requirement for restriction is improper and should be withdrawn.

Withdrawal of the requirement for the restriction with the examination of all claims pending in this application is respectfully requested.

Favorable consideration with early allowance of the pending claims is most earnestly requested.

If the Examiner has any questions, or wishes to discuss this matter, please call the undersigned at the telephone number indicated below.

Respectfully submitted,
Makoto KAIBARA et al.



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April 7, 2005
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